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In re Application of: Gaudet)
Application No. 09/966,094) DECISION ON PETITION FOR
Attorney Docket No. 0023-0040) SUPERVISORY REVIEW REGARDING
Filed: 10/01/2001) FINALITY OF RESTRICTION
For: SCALEABLE GAP INSERTION IN A) REQUIREMENT UNDER 37 CFR
DATA LINK) §1.144

This is in response to the petition filed on June 23, 2004, under 37 CFR 1.144 requesting supervisory review of the finality of a restriction requirement mailed on March 8, 2004. Note, A petition under 37 CFR §1.144 will not be considered if reconsideration of the requirement was not requested (see §1.181).

The petition is **GRANTED**.

RECENT PROSECUTION HISTORY

- (1) A restriction requirement was mailed on December 22, 2003, in which claims 1-24 were subject to restriction and/or election requirement. The application was identified to contain the following patentably distinct species: Species 1 – Fig. 4; Species 2 – Fig. 5; and Species 3 – Fig. 3.
- (2) On January 22, 2004 a response to the restriction requirement was filed in which applicant provisionally elected with traverse species I, drawn to claims 1-3, 5-8, 15-16 and 19-21. Applicant provided reasons in support of the traversal, including a discussion of M.P.E.P. 806.04(f) regarding a proper species restriction.
- (3) On March 8, 2004, the Examiner issued a first office action on the merits, in response to Applicant's election of species I, wherein claims 1-3 and 5-8 were examined, claims 4 and 9-23 were withdrawn. This office action determined the requirement for restriction to be proper and therefore was made FINAL.
- (4) On June 23, 2004, the instant petition was filed by Petitioner, under 37 CFR §1.144.

RELIEF REQUESTED

The instant petition under 37 CFR 1.144 requests the following relief:

- (1) withdrawal (at least in part) of the election requirement of December 22, 2003 (made FINAL on March 8, 2004);
- (2) as a result of item (1), examination of pending claims corresponding to Figs. 4 and 5.

ANALYSIS

Petitioner provides various arguments in support of the withdrawal of the election requirement including reference to M.P.E.P. §806.04(f), which states:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

In addition, note M.P.E.P. §806.03 sets forth:

Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

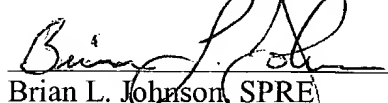
Petitioner states that Figures 4 and 5 (identified Species 1 and 2) are not mutually exclusive. A review of the instant application does in fact set forth that Figs. 4 and 5 are related. Fig. 4 is a block diagram illustrating the escape character insertion component (400) including a specific gap inserter (404). Fig. 5 is indicated to be an illustration of the specific gap inserter (note, 404 apparently mislabeled 402 in Fig. 5), see spec., para. 41 for support. In addition, Petitioner is correct in the analysis that the concept of "mutually exclusive" is not consistent with the concept of "combination and subcombination" as argued by the Examiner in the office action of March 8, 2004. See M.P.E.P. 806.03 - 806.05 for a discussion of election requirement of species versus restriction practice based on related inventions between combination and subcombination.

Thus, and in accordance with M.P.E.P. §806.03(f) and §806.04, the species election requirement of December 22, 2003 between Fig. 4 (Species 1) and Fig. 5 (Species 2) is deemed to be improper.

The petition is **GRANTED**. The previous action and election requirement is **withdrawn** and a new office action will be forthcoming.

The application is being forwarded to the Examiner for appropriate action i.e. prosecution of pending claims drawn to Figures 4 and 5, consistent with this decision.

Any inquiries related to this decision may be directed to the undersigned at (703) 308-0885.


Brian L. Johnson, SPRE 8/9/04
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